

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
BRIEF**

74-1441

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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THE NATIONAL LAMPOON, INC., :

Plaintiff-Appellee, :

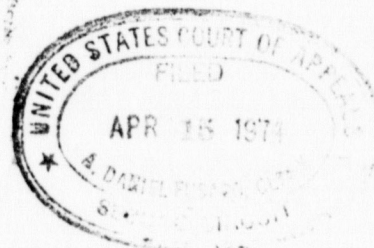
-against- :

AMERICAN BROADCASTING COMPANIES, INC., :
GEORGE SCHLATTER ENTERPRISES, INC. and :
GEORGE SCHLATTER, :

Defendants-Appellants. :
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B
Docket No. 74-1441

BRIEF OF DEFENDANTS-APPELLANTS



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Defendants-Appellants.	:	

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BRIEF OF DEFENDANTS-APPELLANTS

Statement of The Case

Defendants appeal from a judgment entered on April 4, 1974, permanently enjoining them from using:

- 1) the word "lampoon", or any colorable variation thereof, alone or with other words, such as ABC or similar qualifying words, as the title, subtitle or alternate title for a pilot television program, or any television program or series whether based upon that pilot or not; and
- 2) any large set or smaller reproduction of a large set which spells out the word "lampoon" in connection with the pilot program or any television program or series, whether based upon the pilot or not.

The issues were tried in the Southern District of New York before the Honorable Charles L. Brieant, on March 4, 5, 7 and 8. The Court filed its opinion on April 1, 1974. It has not been reported.

The plaintiff is the publisher of a monthly magazine entitled National Lampoon, and is the owner of a registered trademark for "National Lampoon". The plaintiff also produces other properties, all of which bear the mark "National Lampoon".

Defendant George Schlatter Enterprises, Inc. has produced a television program entitled "Lampoon", which employs a large set consisting of the word "lampoon". It was produced as a pilot, that is a prototype for a possible series of television programs, and was to have been broadcast over network facilities of defendant American Broadcasting Companies, Inc.

The action alleged threatened trademark infringement under 15 U.S.C. § 1114, and threatened misrepresentation under 15 U.S.C. § 1125(a). Also alleged were causes of action for threatened unfair competition and violation of New York General Business Law § 368-d.

The action was commenced by service of papers dated February 7, 1974. At that time, plaintiff gave notice that it would move the District Court (S.D.N.Y.) on February 21, 1974, before the Honorable Charles L. Brieant, for a preliminary injunction. Judge Brieant refused to hear the motion on papers alone, and a hearing was subsequently held on March 4, 5, 7 and 8. Post-trial briefs and proposed findings of fact

were submitted on March 20, 1974. Judge Brieant issued his findings and conclusions on April 1, 1974. On April 4, a judgment was entered by the Honorable Charles H. Tenney, based upon Judge Brieant's findings and conclusions, and upon a previous indication to counsel by Judge Brieant as to the outcome of the case.

Defendants immediately filed an appeal of this judgment (on April 4, 1974) upon its entry. On April 5, 1974, the Court of Appeals for the Second Circuit, upon a motion made by defendants, agreed to grant the appeal an expedited treatment. Oral argument has been set by the Court for April 25, 1974.

It is defendants' contention, based upon the arguments contained herein, that the opinion entered by the District Court should be reversed in its entirety, and that its judgment should be vacated. Alternatively, defendants contend that the terms of that injunction should be drastically altered.

SUMMARY OF ARGUMENT

We contend that "lampoon" is used by plaintiff in its generic sense, and that for that reason trademark rights may not inhere in the word as used. The facts will demonstrate that plaintiff's properties are neither more nor less than a series of lampoons.

At the very least, the word is highly descriptive of the material plaintiff publishes and, if this is so, plaintiff can not recover without proving that the word has a secondary meaning, that is to say, when used "lampoon" is understood to identify the plaintiff as the single source of properties having lampoon in the title. We will contend that the plaintiff has not sustained its burden of proof in this regard.

Should it be determined, as we think it should, that plaintiff does employ lampoon in its generic sense, we will show that, even should "secondary meaning" be established, such "secondary meaning" is without legal significance. This flows from the proposition that trademark rights may not be predicated upon words used in their generic, or dictionary, sense.

In support of our contention that plaintiff has failed to prove secondary meaning, we will refer to the Harvard Lampoon, which over the years has established a national reputation. The word lampoon, then, does not identify the plaintiff only. This defeats secondary meaning.

We will refer to the Harvard Lampoon for another reason. The evidence will show that National Lampoon and Harvard Lampoon entered a licensing arrangement, pursuant to which the latter purported to grant the former "trademark" rights in the word "lampoon". However, the Harvard Lampoon has exercised no control over the activities of National

Lampoon. The plaintiff, therefore, has no trademark rights in the word.

If, on the other hand, trademark rights were not granted, it is inconsistent for the plaintiff to claim that defendants can not use "lampoon" when it was free to do so, notwithstanding the notoriety attained by Harvard Lampoon.

Assuming the Court holds that plaintiff's use of the word is not generic, but descriptive, and that secondary meaning has been established, and that trademark rights have not been lost because of Harvard Lampoon's failure to police the plaintiff's activities, we argue that the likelihood of confusion has not been established.

We will show that the Court focused almost all of its attention upon what it apprehended was the bad faith of defendant ABC, and paid but little heed to the crucial element of likelihood of confusion. The evidence does not support the finding of bad faith and, most importantly, does not support the finding of likelihood of confusion.

STATEMENT OF FACTS

George Schlatter is a highly successful television producer (cf. Op.*-22), having produced almost 300 shows in his career (Tr-227). One of Schlatter's best-known shows was a highly popular show called "Laugh-In", which was originally broadcast as a series in January of 1968, and continued to be broadcast for several years thereafter (Op.-22). "Laugh-In" was the first popular TV show to employ a wide variety of humor techniques, such as gags, skits and one-liners, in a "machine-gun" or staccato format (Tr-228).

While Schlatter was still involved with "Laugh-In", he had already conceived of a follow-up show which would employ the same format, but which would be more topical and satirical (Tr-229-30, 243-44). During the summer of 1973, Schlatter actually began writing a "presentation" for the sale of this proposed show (Tr-230-231). Around September or October, he affixed the title "Lampoon" to that work (Tr-230-231). Even before that time, he had discussed the availability of talent for the show with performers as well as with people from the William Morris Agency (Tr-232-236). In these discussions he advised the people with whom he spoke that the tentative title for his proposed show was "Lampoon" (Ibid.)

* References herein to pages of Judge Brieant's opinion are abbreviated: "Op.-#". References to pages of the transcript of the record are abbreviated: "Tr-#". Plaintiff's and defendants' exhibits are abbreviated: "Pl. Ex. #" and "Def. Ex. #", respectively.

Judge Brieant states, at Op.-26, that defendants' proposed show suddenly acquired the title "Lampoon" in November or December, implying that it was suggested to Schlatter by Gary Pudney, ABC Vice President - Variety Programming. This is apparently based on his misreading of Pudney's testimony (cf. Op.-23) to the effect that the series acquired a title in late October or early November. Actually, a reading of the transcript page which Judge Brieant refers to indicates quite clearly that the "presentation" given to Pudney in late October or early November already bore the title "Lampoon". Thus, Schlatter's testimony that he affixed that title in September or October, before giving his presentation to Pudney, is uncontradicted, and Judge Brieant's contrary finding, if that's what it was meant to be, finds no support in the record.

As indicated above, Schlatter approached Pudney with his presentation in late October or early November. It was he, through the presentation, who suggested the use of the title "Lampoon". He had chosen that title because it fit well as a generic definition of what the show would be and do (Tr-249). Pudney liked this presentation, but returned it to Schlatter, asking for some further explanation and an expansion of some of its ideas (Tr-286-287; 470-471). Schlatter took it and used it to prepare a second presentation (Tr-286). The second presentation, defendants' Exhibit 17, marked "Second Draft", was given to ABC in late November or early December (cf. Op.-23).

Before giving the second presentation to ABC, Schlatter had received the results of a title search with reference to the title "lampoon" (cf. Br-24). Those results indicated use of the word in a title by plaintiff as well as others, including Harvard Lampoon, Inc., yet the attorneys who conducted the search advised Schlatter that he would be free to use the title in television, and he proceeded on that basis.

Defendants' proposed show is, as alluded to above, a satire of topical people and events (see Def. Ex. E). It is, as a whole, a lampoon. It was to serve as a "pilot" for a proposed series of shows, which, if approved, would have probably been broadcast commencing in the Fall of this year.

Plaintiff and its products.

1. Nature of plaintiff's activities. National Lampoon, Inc. has, since April of 1970, published a magazine entitled NATIONAL LAMPOON (Br-3). It also sells paperback books, anthologies and "Specials", which are either drawn from past issues of its magazine or contain new material of the same type. It produces posters, polo shirts, and has produced three phonograph albums and a stage revue (Br-11). It has recently begun (November 1973) to produce a "National Lampoon Radio Hour" (Br-13).

2. The essence of plaintiff's products. Each and all of plaintiff's products satirize various subjects, and sharp, biting satire is the essence of all of them (cf. Op.-

3, 12, 13; Tr-21, 34, 40, 41, 52, 84, 91, 99, 411). Each is in its entirety a sharp, biting satire, or a lampoon. See Pl. Ex. 15 which equates plaintiff's publications with "biting satire", and see Tr-390 and 427 at which plaintiff equated "biting satire" with the dictionary definition of "lampoon". See pages 23-26 of defendants' post trial brief for further reference to those portions of the transcript in which plaintiff equates the contents of its publications with the dictionary meaning of the word "lampoon".

3. Plaintiff's mark. Plaintiff's products are identified by the mark "NATIONAL LAMPOON". Contrary to Judge Brieant's finding (Op.-11), a glance at these products (see Pl. Exs. 2, 3, 4, 5, 6) demonstrates that they never bear as a mark the single word "LAMPOON". Plaintiff's registered trademark is NATIONAL LAMPOON. Plaintiff has stipulated that it never used the word "lampoon" alone as the title of any of its publications or productions and that it never requested the word as a trademark or service mark. (Pl. Ex. 1, ¶ 20). Moreover, in spite of plaintiff's contention that it used the word "lampoon" alone in promotional material, the evidence is completely contrary. Tr-209-10, 216-17. Although given the opportunity to present evidence of their type or use (Tr-216-17) plaintiff never offered such, notwithstanding the fact that its principal officer again took the stand for continued examination (Tr-350-82).

4. The scope of plaintiff's activities. The average circulation for NATIONAL LAMPOON was approximately 700,000 copies per month (Op.-9). Plaintiff claims a large "pass-along readership" as well, based upon a survey which it had conducted. However, the testimony elicited at trial demonstrates that this survey is of questionable validity, at best (see Tr-393-347). Plaintiff's stage revue has been reviewed on various outlet stations affiliated with the three networks (Tr-77). (Judge Brieant at several points confused coverage by a local network affiliate on its local news show with coverage on a network-wide news show. Compare Tr-77 and Judge Brieant's reading of it, at Op.-12). Plaintiff's radio show, which is carried primarily on small FM stations, began in November of 1973. It has gradually built up the number of stations on which it is carried so that, at present, it is carried on 156 stations (Pl. Ex. 8).

5. Appeal of plaintiff's products. Plaintiff's products have three noteworthy characteristics: they are very caustic, they very frequently take a "black humor", macabre approach to satire, and they are very frequently "blue" in their content nature. Cf. Pl. Exs. 2-6; see also Pl. Ex. 10, Tr-439, 480; Tr-189-190, where Simmons, plaintiff's chief executive officer and board chairman, admits that this magazine could very well offend a substantial number of people; Op.-3, describing the magazine as irreverent, disrespectful,

and even, offensive. Plaintiff's products appeal to a very limited and specialized audience. They appeal almost exclusively to a young audience and they are predominantly male-oriented. See Pl. Ex. 9, articles by Prouvner, Bierman, McQuay; Pl. Ex. 22; Pl. Ex. 26, promotional material pointing out that NATIONAL LAMPOON and NATIONAL LAMPOON RADIO HOUR are both aimed at a college age audience.

Plaintiff's dealings with ABC.

Early in 1973, representatives of plaintiff met with people from the William Morris Agency, a well-known theatrical booking organization, to discuss the possibility of plaintiff's entering the television field (Op.-16). Arnold Sank, of William Morris, contacted a Fred Rappaport of ABC (Op.-16), who was then working in program development, and served as a funneling house for all submissions of ideas (Tr.-475). (Contrary to Judge Brieant's statement, at Op.-16, Rappaport was not an executive of ABC - see Tr.-129, 474) Mr. Rappaport in turn arranged for a meeting with Gary Pudney, ABC Vice President-Variety Programming (Tr.-474), who was stopping in New York on his way from California to London (Tr.-114). The meeting was held on July 26 (Op.-16). Judge Brieant found that Pudney expressed interest in further negotiations (Op.-18). This is not only totally unsupported by the evidence, but it is also totally illogical. As Judge Brieant notes (Op.-17), plaintiff's people stated at the meeting that they would only think of doing specials, yet Pudney had nothing to do with specials at ABC. Furthermore, he was under the

impression, both before and after seeing plaintiff's magazine, that its material was caustic, blue and not suitable for television (Tr.-479-480). He expressed his lack of interest to a William Morris representative on his return to California (Tr.-479). Sank's later actions best describe his real impression as to Pudney's interest - he states that after hearing from associates within the next few weeks that Pudney was still thinking about it, he did nothing further with regard to the matter (Tr.-117-118). Indeed, plaintiff made no further contact with ABC until November.

In November of 1973, plaintiff's representatives had a second meeting with ABC, this time with Jim Hay, ABC's Director of Specials (cf. Op.-20-21). Judge Brieant apparently infers from this that ABC's interest in the plaintiff's proposed project remained active (Id.). Again, this conclusion does not follow at all. The testimony clearly establishes, and Judge Brieant's opinion does not dispute the fact, that Hay knew nothing of plaintiff's meeting with Pudney when he met with plaintiff's representatives (Tr.-442; cf. Op.-21). Once again, it was plaintiff's representative that arranged for the meeting (Tr.-435). Like Pudney, Hay was of the belief that plaintiff's materials were not acceptable for television (Tr.-439; see also Tr.-139; Memoli, the William Morris representative for plaintiff at the time, confirms that Hay was concerned about the subject matter of plaintiff's products.)

Plaintiff's proposed entry into television.

At Op.-15, Judge Briant stated: "It was natural to foresee expansion of plaintiff's activities to national television." Not only is plaintiff not presently involved in national television, but the record also indicates clearly that plaintiff has no viable means of entering that area in the foreseeable future. Its rather vague plans for producing several close-circuit "television" shows is a far cry from producing and selling a network TV show. As discussed above, the quality of its materials is not suitable for television. In addition, the prospect of producing a set of four to six shows, as its people assert that it plans to do, is beyond its staff's capability. Its radio show has already been cut to a half-hour because, even with present demands, the original length was too taxing for plaintiff's writers (Tr.-191-192). Moreover, the plaintiff itself could not or did not care to prepare a written presentation for a viable show for submission to ABC when they met with ABC (cf. Hay's testimony at Tr.-437). Indeed, a specific project or program wasn't even discussed (Tr.-436).

The conduct of plaintiff's representatives at the William Morris Agency evidences their feeling toward the viability of plaintiff's proposed entry into TV. For example, though Sank stated that he was informed that Pudney was still thinking about the proposed show (Tr.-117), he testified that he (Sank) did nothing further with regard to the matter (Tr.-

117-118). (Simmons himself didn't meet with any other networks either (Tr.-103).) Simmons also stated (at Tr.-97-98) that at one meeting with the agency some 20 to 25 William Morris executives were present when his proposed project was discussed. Now Sank (at Tr.-111) testified that when a project, idea or proposed production comes into the agency, the input of the entire agency is placed behind it, the entire agency apparently being made aware of it and working for it. Thus, there would have been a general awareness of the proposed project of the plaintiff among the people at the agency, at least if that project were considered a viable one.

Schlatter testified (Tr.-231-237) that he had spoken to people in the William Morris Agency and to talent represented by that agency with regard to his proposed show. In those discussions he advised that the name for his show would be "Lampoon". One of the persons with whom he spoke was Art Buchwald, who is represented by plaintiff's witness Arnold Sank. Throughout these negotiations with talent and the William Morris Agency, which continued through the Fall of 1973, the William Morris Agency never mentioned to Schlatter that the plaintiff was planning to put on a show under a title containing "National Lampoon". Likewise, the agency apparently never informed the plaintiff of Schlatter's proposed show or title.

There was testimony, at Tr.-96, that the William

Morris Agency receives a percentage of whatever is earned through the sale of a production. Since the percentage to be gained by the agency from the sale of a production would obviously far outweigh the percentage which would be gained for the "sale" of a particular talent for a guest appearance, it would have been in the best interests of the agency to provide full protection for plaintiff's proposed show if it thought that that show was indeed possible. Its failure to relay the information it had to either party demonstrates one of two possibilities: either the agency didn't believe that the titles would present any problem in running on TV at the same time, or they did not really believe that plaintiff's proposal for a show had any real viability.

The Harvard Lampoon.

Harvard Lampoon is a satirical magazine published by the students of Harvard University. It has been published since February of 1876 (Tr.389; Op.-4). Harvard Lampoon is available to the public, and is circulated to libraries, universities and cities around the country (Tr.-389). Subscriptions to the magazine are made available in issues of the NATIONAL LAMPOON, as well as in special parody issues of national magazines published by the HARVARD LAMPOON.

The HARVARD LAMPOON has a national reputation. In part, this has been achieved through a variety of special presentations and projects. For example, it has published "parody issues" of various magazines, including COSMOPOLITAN,

LIFE, TIME, PLAYBOY and ESQUIRE (see plaintiff's Exhibit 12). The COSMOPOLITAN parody issue enjoyed a circulation, according to plaintiff, of between 900,000 and 1,000,000 copies (Tr.-207). Plaintiff admits that the other parody issues enjoyed circulations of at least half that size (Tr.-207). These issues, and other parodies similar to them, have received nationwide publicity, including coverage in major magazines and newspapers. (See Def. Ex. B; cf. Tr.-209)

In addition to the parody issues referred to above, Harvard Lampoon has put on various stunts which have received national notoriety and attention. For example, every year the Harvard Lampoon gives out worst actor and actress of the year awards, somewhat along the lines of an Oscar. Plaintiff's witness, Henry Beard, testified that while he was a student editor of the Lampoon such an award was given to Natalie Wood (cf. Def. Ex. I - 1966 Newsweek article; Tr.-428-429). This award in its presentation received major and extensive publicity and television and press coverage (Ibid). The Lampoon, he testified, had a nationwide notoriety (Ibid).

Recently, Harvard Lampoon gave worst actor and actress awards to John Wayne and to Linda Lovelace (cf. Def. Ex. I - articles from Newsweek and Time). These, likewise achieved nationwide notoriety through nationwide publicity (see Def. Exs. I, J), including nationwide television coverage on the three television networks (Tr.-465) (as opposed to coverage by some local stations as has been claimed for certain

productions of the plaintiff -- see the script of the ABC network news show's coverage of this event, Def. Ex. G).

Not only did the evidence show that the Harvard Lampoon had, and now has, a national reputation, but it also demonstrated that the word "lampoon" is employed to designate and refer to the Harvard Lampoon in the same way plaintiff claims the word is used to designate and refer to the National Lampoon. See pages 28-34 of our post-hearing memorandum and compare with Def. Ex. B and that portion of Pl. Ex. 12, consisting of the Harvard Lampoon's parody of ESQUIRE magazine in MADEMOISELLE.

The second point to be made respecting the Harvard Lampoon is the nature of its relationship with the plaintiff. Contrary to the implication of Judge Brieant's opinion, at Op.-9, plaintiff is not, in any way, related to, or affiliated with, the Harvard Lampoon, Inc., apart from the licensor-licensee relationship to be discussed below. Plaintiff's present company handled the physical publication and distribution (with no writing involved) of one of Harvard Lampoon's parody issues, the COSMOPOLITAN issue (cf. Pl. Ex. 27), and, years ago, one of the parent's personnel had given some advice on two other parody issues prior to plaintiff's coming into existence (Tr.-68-69). Beyond this, Judge Brieant's statement that the plaintiff assisted with other parody issues of Harvard Lampoon in the past is totally erroneous, with no support found in the record.

Harvard Lampoon, Inc. licensed plaintiff to use the word "lampoon" on its products by a document executed on October 8, 1969 (Def. Ex. A). That license calls for review of the contents of NATIONAL LAMPOON by the personnel of Harvard Lampoon, Inc. Judge Brieant concluded (at 6, 7) that the steps taken by the parties to implement that agreement, and its administration, have been sufficient to preclude a determination that the license is a "naked license". However, Judge Brieant passes over in silence the facts elicited at trial as to how that agreement has been administered in fact. The facts, which prove Judge Brieant's conclusion totally erroneous, are as follows: According to Simmons and Beard (editor of NATIONAL LAMPOON), plaintiff initially sent proofs of its magazine to the staff of Harvard Lampoon, Inc., seeking their review of the content of plaintiff's magazine. The Harvard Lampoon personnel could not do anything with these proofs, didn't even have time to read them, because of the burden placed upon them by their classes and so forth (Tr.-200). Because of this, arrangements were made for copies of plaintiff's magazine in final form to be sent to the Harvard Lampoon (Tr.200). No indication was given as to how the sending of the copies of the magazine made the task of the personnel of the Harvard Lampoon any more feasible than it was when they were sent the proofs.

Under the present arrangement, Simmons admitted that no pre-publication editorial control has been exercised by

Harvard Lampoon, Inc. over the NATIONAL LAMPOON for about four years (Tr.-201-202). Rather, National Lampoon sends copies "off the press" to the Harvard Lampoon (Tr.-392-393). According to Beard's (i.e., NATIONAL LAMPOON's editor's) estimate, this is about five to seven days before general distribution of the magazine (Tr.-430). However, Beard admits that it could take at least that number of days for the copies to even reach the Harvard Lampoon (id.). In addition, though Beard is apparently the one responsible for handling the submission of the copies to the Harvard Lampoon (Tr.-202), he can't even say for sure if each of the magazines is even sent (Tr.-431).

As to the action which would be taken by National Lampoon if Harvard Lampoon were upset by anything contained therein, Beard states that such misgivings on the part of Harvard Lampoon would be taken under serious consideration by plaintiff (Tr.-392-393). Such consideration, after publication, with no guarantee of compliance, is the strongest "control" which plaintiff would concede to Harvard Lampoon, even if the latter did receive all copies of the magazine and did in fact attempt to exercise control. Even with regard to this vague semblance of control, there is no written record of any exercise of control through this mechanism (Tr.-432-433). Beard states that he can vaguely recall one telephone call from Harvard Lampoon several years ago, which resulted in no specific action taken upon the suggestion of the Harvard Lampoon (Tr.-393). It is apparent, then, that Harvard Lampoon exercises no control over plaintiff.

ARGUMENT

PLAINTIFF CAN HAVE NO TRADEMARK RIGHTS IN THE WORD "LAMPOON" BECAUSE THE WORD AS USED BY PLAINTIFF IS A USE IN ITS GENERIC OR PRIMARY SENSE.

Underlying every aspect of this case is a fundamental policy question -- i.e., to what extent, if any, can plaintiff claim exclusivity in the use of the ordinary dictionary word "lampoon", given the nature of its present use of the word and the nature of defendants' proposed use. It is defendants' contention that plaintiff can claim no such right, because its use of that word is a use in a generic sense and because defendants' proposed use is a use in a generic sense.

There is an established rule of trademark law that a generic name for a product cannot be appropriated for exclusive use by the maker of such product. Such terms are deemed incapable of satisfying the language of 15 U.S.C. § 1052, i.e., "trademark by which the goods of the applicant may be distinguished from the goods of others". Cf. 1 McCARTHY, TRADEMARKS AND UNFAIR COMPETITION (hereinafter "McCarthy") § 12:18 (1973), at 441. Apart from the fact that such terms constitute the very antithesis of what is meant as a trademark in that they indicate what the product is rather than the source from which it came (cf. Id., § 12:1, at 405), two strong policy reasons support this rule: (1) it is contrary to public policy to allow a prior user to shackle the English language by appropriating exclusively to himself the right to ascribe to his product its generic name; and (2) in many

instances the grant of the exclusive right to use in trade the generic name for a product would also inhibit the sale of such product by others, and would thus lead to a grant of a monopoly quite apart from the rights granted by the federal patent or copyright statutes, which constitute the only accepted avenues to receiving such monopolies.

A generic name or term is one that answers the question "What are you?". 1 McCarthy, § 12:2, at 406. Expressed another way, it is a term which ends the sentence "This is a _____" in reference to the particular product. Thus, in Henry Heide, Incorporated v. George Ziegler Company, 354 F.2d 574 (7th Cir. 1965), the Seventh Circuit Court refused to grant recognition to the plaintiff's trademark "JUJUBES" as applied to a gum-type candy because "jujube" was a noun meaning a gum type candy, and the plaintiff's product were "jujubes". Donald F. Duncan, Inc. v. Royal Tops Manufacturing Company, 343 F.2d 655 (7th Cir. 1965), is to the same effect with regard to the plaintiff's mark "yo-yo" in connection with the toy of that name. And the same result was also reached with regard to the following terms:

- TURBODIESEL with regard to a type of engine - Cummins Engine Company v. Continental Motors Corp., 359 F.2d 892 (CCPA 1966).
- HA-LUSH-KA for noodles, where that was the Hungarian equivalent of "noodles" - Weiss Noodle Co. v. Golden Cracknel And Specialty Co., 290 F.2d 845 (CCPA 1961).
- CALCITE CRYSTALS for poultry feed made up of crystalline limestone, where calcite is a dictionary term for ground limestone -

Application of Limestone Products Corp. of America, 312 F.2d 825 (CCPA 1963).

Judge Brieant nominally recognized the rule (Op.-37), that trademark protection is not available for a generic term generically used. It would seem, however, that both he and plaintiff's counsel have failed to distinguish between cases dealing with generic terms generically employed and those dealing with dictionary words used in a non-generic sense. (Typical examples of the latter type of case are given at Op.-36-37). Defendants do not argue that ordinary words cannot receive trademark protection, if they are terms used in either a "descriptive" or "suggestive" sense. See generally, 1 McCARTHY, Chapter 11. In the case of descriptive words, protection is afforded if the claimant has established a secondary meaning for the term - i.e., the primary significance of the term in the consuming public's mind is a reference to a single source of the goods rather than a reference to the goods themselves. (A full discussion of this concept, secondary meaning, is found, infra.)

A "descriptive" mark, as discussed above, is a term which is descriptive of the qualities, ingredients or characteristics of the product bearing the mark. These marks, however, do not answer the question "What is this?", as does a generic term. For example, the product in Hanson v. Triangle Publications, Inc., 163 F.2d 74 (8th Cir. 1947) could never

have been correctly referred to as "a Seventeen" (suggestive term as applied to a teenage magazine). Nor could the finger-nail clippers in W.E. Bassett Co. v. Revlon, Inc., 354 F.2d 868 (2d Cir. 1966) be referred to as a TRIM (held descriptive, of function). These terms, therefore, do not serve the same role as a term which names the genus of products, and thus, the policy against their appropriation is not so strong.

On the other hand, once it is established that a term is used in its generic sense, no amount of evidence purporting to show secondary meaning can lead to trademark protection. There are times when a plaintiff can show "secondary meaning" because it was or is the sole commercial user of a common term or the sole source for the genus of products. But the courts refuse to grant any recognition to this "de facto secondary meaning." 1 McCARTHY §§ 12:14, 12:15; Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938). The law in this respect was aptly summarized by the Court of Customs and Patent Appeals in Weiss Noodle Co. v. Golden Cracknel And Specialty Co., supra. After observing that merchants act at their peril in attempting to convert common names to their exclusive use the court stated:

"Even though they succeed in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect. When the board said Ha-Lush-Ka could not acquire a secondary meaning it meant that no secondary meaning of legal significance could be acquired." Weiss Noodle Co. v. Golden Cracknel And Specialty Co., 290 F.2d 845, 848 (CCPA 1961)

Similarly, in Henry Heide, Incorporated v. George Ziegler Company, supra, 354 F.2d 574 (7th Cir. 1965) evidence of use and advertising, and a survey purporting to show that 74% of the consuming public identified the word "jujube" with plaintiff's product, were of no avail in plaintiff's attempt to claim trademark protection for the term JUJUBE. And in Cummins Engine Company v. Continental Motors Corp., supra, 359 F.2d 892 (CCPA 1966), in response to the contention that some \$400,000 had been spent in promoting the mark the court stated:

"And while respondent has made extensive use of this term and has expended a large sum in promoting its goods in connection with which this term has been used, the Court in Weiss Noodle Company v. Golden Cracknel and Specialty Company, *** [48 CCPA 1004, 290 F.2d 845, 129 USPQ 411]; when presented with a similar argument, aptly stated 'While it is always distressing to contemplate a situation in which money has been invested in a promotion in the mistaken belief that trademark rights of value are being created, merchants act at their peril in attempting, by advertising, to convert common descriptive names, which belong to the public, to their own exclusive use'." (at 895)

It follows, then, that if "lampoon", as used by plaintiff, is a generic name for its products, no trademark protection could be afforded, even if plaintiff had produced evidence of "de facto secondary meaning".

Judge Brieant skirted this by concluding that "lampoon" is not such a generic term. (Br. 38-39) The Court stated (Op.-38) that the term "describes humor, in the sense of sharp, biting wit", yet at the same time, it stated that

it does not identify a type or classification of humor. He found that the word does not signify a magazine, and is in his opinion an unusual and uncommon word.

The totality of this reasoning, as it pertains to the issue of generic usage, is patently defective. At n. 6, pp. vi-viii, of Judge Brieant's own opinion are set forth six dictionary definitions of "lampoon", each of which identifies the word as a noun (rather than an adjective) defined, in essence, as a sharp, biting satire. See also ROGET'S INTERNATIONAL THESAURUS, at 620-621, §969.5, .7, .12, indicating that the word is synonymous with the noun "satire". This is in complete accord with the understanding of the term's meaning expressed by NATIONAL LAMPOON'S editor (Tr-390).

Is each and every of plaintiff's products a sharp, biting satire? A reading of or listening to them indicates that each is a sharp, biting satire, a lampoon. Judge Brieant's findings confirm that the products are biting satires (see Op.-3, 12, 13). Indeed, his characterization of the said products at the cited pages squarely fits the dictionary meaning of "lampoon". This is completely consonant with the testimony elicited at trial. See defendants' post trial brief, pages 23-26, for a discussion of the evidence on this issue. It is indisputable, then, that each of plaintiff's products contains nothing but "sharp, biting satires" (lampoons), and each is, as a whole, a sharp, biting satire, a lampoon. "Lampoon" is thus a generic name for each of the products.

Judge Brieant's statement to the effect that "lampoon" does not mean "magazine", is if no consequence at all in this respect. The mere fact that another generic term can be thought of for a product, indeed, might be thought of first, or that a product could be simultaneously placed in several "genera", has nothing to do with the fact of a given word's generic usage in reference to the product. Were Judge Brieant's reasoning carried to its end, "comedy", "novel", "story", or "drama" could never serve a generic function because they might not immediately signify the specific form (*i.e.*, book, film, etc.) in which they were embodied. Yet each is in fact a generic word for a genus of products. This argument, which plaintiff successfully urged in the District Court, is virtually the same as was rejected in J. Kohnstam Ltd. v. Louis Marx & Co., 280 F.2d 437 (CCPA 1960) and American Montessori Soc. v. Ass'n Montessori International, 155 U.S.P.Q. 591 (TMT & App. Bd. 1967).

Nor can Judge Brieant's statement that "lampoon" is an unusual word be given any weight. First of all, the word is far from uncommon. It can be found in any dictionary or high school vocabulary book, and its common use was in fact virtually conceded by NATIONAL LAMPOON'S editor, Beard, who noted that he had seen it used in its dictionary sense in newspapers over the past ten years. (Tr-391).

Judge Brieant, himself, indicates that the word is used popularly today (Op.-39), as well he might, for even plaintiff uses it frequently in its dictionary sense. (Cf. Pl. Ex. 15) Judge Brieant attempts to explain this away by saying that the word's popularity was brought about by plaintiff's and HARVARD LAMPOON'S recent popularity. Again, this is defective. The word was a widely used word long before 1970, when NATIONAL LAMPOON first came into existence. Interestingly, five of the six dictionaries cited by Judge Brieant in defining lampoon were published before that year. Furthermore, even if it were so (a preposterous notion), the idea that "lampoon" is used today in its dictionary sense because of the current activities of plaintiff would not alter the fact that it is today a commonly used dictionary word. The list of cases wherein a one-time arbitrary term became generic clearly demonstrates that even a formerly arbitrary term would, in those circumstances, be treated as generic, and not be subject to trademark protection. See, e.g., Dupont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2d Cir.), cert. denied, 299 U.S. 601 (1936) (Cellophane). In the case at hand the court need not be concerned with the public's understanding of "lampoon", an issue in the Cellophane case, because "lampoon", unlike "Cellophane", has an established dictionary meaning.

In summation, "lampoon", as used by plaintiff, is a generic term, as each of the plaintiff's products bearing the mark is a lampoon. Thus, plaintiff cannot claim the exclusive right to use that word on a product. This is particularly fitting in this instance, for defendants' use is a generic one as well. A reading of Def. Ex. E illustrates that Schlatter's program is a lampoon. The relief which plaintiff seeks, then, and which Judge Brieant has afforded, is a denial of George Schlatter's right to call his show a common dictionary name for that product.

This, we submit, should be clear. In the first place, "no sign or form of words can be appropriated as a valid trademark, which from the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right for the same purpose." Manitou Springs Mineral Water Co. v. Schreiber, 239 Fed. 593, 598 (8th Cir. 1917); 3 CALLMAN, UNFAIR COMPETITION TRADEMARKS AND MONOPOLIES (3rd ed. 1969), at 106. The defendants are employing "lampoon" in its primary sense and are no less entitled to do so than plaintiff or the Harvard Lampoon.

In the second place, even if we assume the possibility of some confusion, such is the consequence of plaintiff's conscious use of a word in its primary descriptive, if not generic, sense.

"It is settled, beyond all controversy, that a manufacturer has no right to the exclusive use of a descriptive word in connection with his goods, and if nevertheless he adopts such a

trade-mark, he himself is largely to blame for the confusion which ensues when other manufacturers, with equal right, adopt similar terms to describe their products." Bliss, Fabyan & Co. v. Aileen Mills, Inc., 25 F. 2d 370, 372 (4th Cir. 1928).

PLAINTIFF FAILED TO ESTABLISH SECONDARY
MEANING FOR THE WORD LAMPOON

Judge Brieant's opinion contains no finding in support of his conclusion that "lampoon" acquired a secondary meaning. At Op.-34, he stated: "Strong evidence of secondary meaning has been presented . . .", and at Op.-39: "Plaintiff's substantial activities seem to have acquired for its mark secondary meaning . . ." (Emphasis supplied). No other discussion of secondary meaning is provided. Indeed Judge Brieant goes to some length (see Op.-34-35) in attempting to show that proof of secondary meaning is not really necessary in this case. This latter view, we submit, is completely incorrect. Furthermore, if Judge Brieant has found secondary meaning, his finding is clearly erroneous in light of the record.

Judge Brieant placed principal reliance upon the often misunderstood case of Santa's Workshop Inc. v. Sterling, 282 App. Div. 328 (3rd Dep't 1953), to indicate that plaintiff need not demonstrate secondary meaning to prevail in this action. Decisions following Santa's Workshop indicate that the statement provided in Judge Brieant's opinion is not the law of New York. For example, in 1961 the New York Court of Appeals firmly held to the view that secondary meaning is essential to an unfair competition action of the type involved here. See, Dell Publishing Co. v. Stanley Publishing, Inc., 9 N.Y. 2d 126 (1961). See also, Speedry Products, Inc. v.

Dri Mark Products, Inc., 271 F. 2d 646, 649-50 (2d Cir. 1959), in which this court analyzed Santa's Workshop, and concluded that under New York law secondary meaning may not be necessary only in situations where the defendant is charged with appropriating the plaintiff's plan and scheme of doing business, for in such cases the element of confusion plays no role. Where, however, confusion is an element, as it is in our case, secondary meaning must be established. Id. at 650.

Judge Brieant indicated, at Op.-38, 39, that "lampoon" was a descriptive rather than generic term, and that plaintiff must prove secondary meaning before protection can be afforded that word. Op.-36, 38-39. Secondary meaning, in this sense, is created when the primary significance of the term in the minds of the consuming public is not the product but a single producer. Cf., Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938). This doesn't mean a subordinate or rare significance - rather, it means a subsequent significance added to the previous meaning of the designation and becoming in the market its usual and primary significance. RESTATEMENT, TORTS § 716, Comment b (1938).

McCarthy discusses the rationale behind the secondary meaning requirement as follows:

"A fundamental purpose of trademark law and unfair competition law is to prevent confusion of buyers. If the plaintiff's business symbol is inherently non-distinctive, then to prove a likelihood of confusion, it appears essential that plaintiff prove, through some reliable evidence, that buyers associate that symbol with him and that, therefore, defendant's usage will in fact cause confusion." McCarthy §15:5, at 532.

He describes the concept of secondary meaning as follows:

"To acquire a secondary meaning in the minds of the buying public, a labelled product, when shown to a prospective customer, must prompt the reaction, 'That is the product I want because I know that all products with that label come from a single source and have the same level of quality'. If the label merely prompts the question, 'Who makes that product?', this is not an association or recognition sufficient for secondary meaning. In other words, the article must proclaim its identity of source and quality, and not simply to stimulate further enquiry about it. As one court stated, 'The buyer to be deceived, must be looking for something'.

"Thus, the buyer is not confused unless he is looking for a label he recognizes and picks up another in his confusion. Ergo, a buyer who does not recognize plaintiff's 'mark' and does not distinguish it from any other, cannot be confused. 'A casual buyer who did not buy by the brand might pick up one can for the other. But in that case, he is not the plaintiff's prospective customer. . . . his selection of one in preference to the other does not involve the type of choice as to which the law is anxious to avoid confusing deception." Id., §15:3, at 523.

Plaintiff failed completely to demonstrate that any consumer identification with a single source such as that described above would result in connection with the word "lampoon". In this context, it must be kept in mind that the more descriptive or common the word involved, the greater is the evidentiary burden on the user to establish secondary meaning.

3 CALLMAN, UNFAIR COMPETITION TRADEMARKS AND MONOPOLIES 357 (3d ed. 1969). If lampoon is descriptive, as Judge Brieant found, rather than generic, it is a common word which is at least very "highly descriptive", and

plaintiff's burden was thus a very extreme one.

Plaintiff attempted to demonstrate secondary meaning by pointing to various circulation figures, advertising expenditures and the like, in an attempt to demonstrate a widespread exposure of its mark to the public. Such evidence, with nothing more, is irrelevant. Large expenditures of money and circulation figures cannot alone automatically demonstrate secondary meaning.

"The test of secondary meaning is the effectiveness of the effort to create it, and the chief enquiry is directed towards the consumer's attitude about the mark in question: does it denote to him a 'single thing coming from a single source?'. Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F. 2d 794 (9th Cir. 1970), at 802 (Emphasis supplied).

Plaintiff introduced no evidence tending to show that the public would identify the word "lampoon" with it. True it is that plaintiff introduced several clippings, letters and so forth, in which it was referred to as "Lampoon". However, there is not one of these in which "Lampoon" is used to refer to plaintiff without either a contextual reference to National Lampoon to clarify what is meant or a surrounding context in which it is obvious that National Lampoon is meant (e.g., in the letters to the editors of NATIONAL LAMPOON). Courts have recognized that such use of a term is no more than "journalistic shorthand", and is of no probative value whatsoever with regard to the question of secondary meaning. See, e.g., Anderson v. National Broadcasting Company, 178 F. Supp. 762

(S.D.N.Y. 1959), at 765 (with reference to "The Law of the Plainsman" and "The Plainsman").

In contrast to this lack of firm evidence, the following must be kept in mind. First, the word "lampoon" is a common, dictionary word, generic as to defendants' product. The first inclination of the public would be to link that word with the content of the show rather than with any source.

Second, plaintiff has been in existence but four short years. Most of its products have been in existence for a much shorter period than that. For example, its radio show first went on the air just last November.

Third, in the same area as plaintiff is another, better known satirical magazine employing the word "Lampoon" in its title. HARVARD LAMPOON, Harvard University's satirical magazine, has been in existence since 1876 (Op.-4). Contrary to Judge Briant's statement, it is not affiliated with National Lampoon, Inc. It is circulated to libraries, universities and cities throughout the country (Tr.-389). Subscriptions for it are made available in NATIONAL LAMPOON.

The HARVARD LAMPOON has received particular notoriety over the years because of its activities. For example, it has published and had circulated nationally "parody issues" of various magazines, including COSMOPOLITAN, LIFE, TIME, PLAYBOY and ESQUIRE (see Pl. Ex. 12). The circulation of these has been nationwide, and has surpassed that of NATIONAL LAMPOON (Tr.-207). These parody issues have received nationwide publi-

city, including coverage in major magazines and newspapers. (See, Def. Ex. B; Cf. Tr.-209). Harvard Lampoon has also received notoriety through other stunts, such as its annual worst actor and actress awards. These also have received nationwide publicity, including coverage by major newspapers, magazines and network T.V. (See, Def. Ex's I, J).

If the public were to identify the word "lampoon" with a given source, it's far more likely that they would do so with reference to HARVARD LAMPOON. Plaintiff's own witness, Sank, testified that "lampoon", among some people in the industry, was used interchangeably to mean the Harvard Lampoon or National Lampoon (Tr.-118). But, even if they thought of both plaintiff and HARVARD LAMPOON as possible sources, they would not have identified the product with a single source. They would either be led to further inquiry as to source, or they would proceed with indifference as to source. In either instance, as the quotation above from McCARTHY indicates, this is not secondary meaning.

In light of all the above, it's clear that no finding of secondary meaning could possibly be based upon the record below.

PLAINTIFF CAN CLAIM NO PROTECTION
FOR THE WORD LAMPOON SINCE IT USES
THAT TERM UNDER A NAKED LICENSE.

Plaintiff uses the word "lampoon" in its trademark "National Lampoon" pursuant to a license agreement (Ex. A) between itself and Harvard Lampoon, Inc., a corporation which has used the mark HARVARD LAMPOON throughout the country since 1876 (cf.Op.-4). If the word "lampoon" alone can, as plaintiff contends, have trademark significance, plaintiff cannot validly claim trademark protection for that word, since this license under which it uses the term is a "naked license".

A license to use a trademark on a product absent the retention of any kind of control over the standards applied to that product, is referred to as a "naked license". Such licensing, whereby the licensee can place the mark on any kind or quality of goods, causes the mark to lose its distinctive significance, and causes a grave danger that the public will be deceived. Cf. Dawn Donut Co. v. Hart's Food Stores, 267 F. 2d 358 (2d Cir. 1959). Both the Second Circuit, with reference to the Lanham Act, and New York Courts, with regard to New York law, have recognized that naked licensing, without quality control, is a fraud on the public and un-

lawful. See Societe Comptoir De L'Industrie Cotonniere Etablissements Boussac v. Alexander's Department Stores Inc., 299 F.2d 33 (2d Cir. 1962), at 35; Ritz Associates, Inc. v. Ritz-Carlton Hotel Company, Inc., 35 Misc.2d 425 (Sup. Ct. 1962), aff'd, on opinion below, 19 App.Div.2d 522 (1st Dept. 1963), aff'd without opinion, 14 N.Y.2d 670 (1964). Such a license conveys no rights. American Broadcasting Co. v. Wahl, 121 F.2d 412 (2d Cir. 1941); Adrian v. Unterman, 281 App. Div. 81, 87 (1st Dept. 1952), aff'd 306 N.Y. 771 (1954).

As Judge Brieant pointed out in his opinion (Op.-6), the mere existence of an agreement calling for some form of quality control by a licensor is insufficient to negate the existence of a naked license. Rather,

"The critical question is whether the plaintiff sufficiently policed and inspected its licensees' operations to guarantee the quality of the products they sold under its trademarks to the public." Dawn Donut Company v. Hart's Food Stores, Inc., 267 F.2d 358, 367 (2d Cir. 1959).

Judge Brieant found (Op.-6) that steps taken by the parties to implement Harvard Lampoon's rights and powers were sufficient to assure that the quality of plaintiff's product would be satisfactory to Harvard Lampoon. However, Judge Brieant could not refer to any evidence which demonstrates actual control by Harvard Lampoon. And the testimony at trial indicated clearly that no such control does exist.

For the first few months of plaintiff's publication, proofs of plaintiff's magazine were sent to the Harvard Lampoon

staff for their review. According to Simmons (plaintiff's chief executive officer), the Harvard Lampoon personnel could not do anything with these proofs because of the burden placed upon them by their classes and so forth (Tr-200). Because of this, within months of the inception of publication of NATIONAL LAMPOON, arrangements were made for copies of plaintiff's magazine in final form to be sent to the Harvard Lampoon (Tr-200). No indication was given as to how the sending of the copies of the magazine made the task of the personnel of the Harvard Lampoon any more feasible than it was when they were sent the proofs.

Under the present arrangement, Simmons himself confirmed that no pre-publication editorial control has been exercised by Harvard Lampoon, Inc. over the NATIONAL LAMPOON for about four years (Tr-201-202). Rather, National Lampoon sends copies "off the press" to the Harvard Lampoon (Tr-392-393). According to Beard's (NATIONAL LAMPOON'S editor) estimate, this is about five to seven days before general distribution of the magazine. (Tr-430). However, Beard admits that it could take at least that number of days for the copies to even reach the Harvard Lampoon (Id.). In addition, though Beard is apparently the one responsible for handling the submission of the copies to the Harvard Lampoon (Tr-202), he could not say for sure that each of the magazines is even sent (Tr-431). As to the action which

would be taken by National Lampoon if Harvard Lampoon were upset by anything contained therein, Beard states that such misgivings on the part of Harvard Lampoon would be taken under serious consideration by plaintiff (Tr-392-393). Such consideration, after publication, with no guarantee of compliance, is the strongest "control" which plaintiff would concede to Harvard Lampoon, even if the latter did receive all copies of the magazine and did in fact attempt to exercise control. Even with regard to this vague semblance of control, there is no written record of any exercise of control through this mechanism (Tr-432). Beard states that he can vaguely recall one telephone call from the Harvard Lampoon in 1971, which resulted in no specific action taken upon the suggestion made by the Harvard Lampoon (Tr-393). It is apparent, then, that Harvard Lampoon exercises no control over plaintiff.

If, as plaintiff contends, the word "lampoon", in and of itself, has trademark significance, plaintiff's continued and present use of that mark under a naked license would constitute a practice recognized as deceptive of the public, a type of practice which trademark law is aimed at preventing. Cf., Dawn Donut, supra. Plaintiff, then, would be in no position to approach a Court requesting equitable relief and would have no interest in the mark.

If, on the other hand, the marks NATIONAL LAMPOON

and HARVARD LAMPOON are sufficiently distinct to prevent confusion in the public's eye and to allow valid registration of the former even though both serve as titles of magazines, it would be completely inconsistent to assert that defendants cannot use the title LAMPOON as they propose in an entirely different medium.

Thus, in either case, plaintiff cannot successfully claim either trademark infringement or unfair competition. In the first situation it has no interest in the word; in the second, the word has no trademark significance.

Before moving to the next point in our argument, there are two other facets of NATIONAL LAMPOON'S relationship with the HARVARD LAMPOON which must be considered. First of all, only the owner of a mark can register it under the federal trademark statute. 15 U.S.C. § 1051. If, as plaintiff contends, the word "lampoon" in and of itself has trademark significance, plaintiff should not have been allowed to register it, for it was not the owner of that mark, but was rather a mere licensee with regard to its use.

Secondly, if that word does have trademark significance, plaintiff made two material misrepresentations of fact in applying for its trademark registration. With full knowledge of Harvard Lampoon, Inc.'s interest in the word, it (a) stated that it was the owner of the mark, and (b) stated that to its knowledge no other person or entity had the right to use in

commerce either the identical term or one of such near resemblance as might be calculated to deceive. Such misrepresentations in and of themselves would render plaintiff's mark cancellable. See Bart Schwartz International Textiles, Ltd. v. Federal Trade Commission, 289 F.2d 665 (CCPA 1961).

DEFENDANTS' PROPOSED USE OF "LAMPOON" WOULD NOT
RESULT IN A LIKELIHOOD OF CONFUSION

Even if the principles discussed above did not already render Judge Brieant's holding unsound, that decision should nonetheless be reversed, for plaintiff has not established "likelihood of confusion", which is the basic requirement of any action in either trademark infringement or unfair competition. The elements to be considered in judging likelihood of confusion have been summarized by this Court as follows:

"Where the products are different, the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers. Even this extensive catalogue does not exhaust the possibilities - the court may have to take still other variables into account. American Law Institute, Restatement of Torts, §§ 729, 730, 731." Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2d Cir. 1961), at 495. See also King Research, Inc. v. Shulton, Inc., 454 F.2d 66 (2d Cir. 1972).

While findings on several of these factors are deemed

to be findings of fact, subject to the "clearly erroneous" test, the ultimate conclusion as to likelihood of confusion is one which the appellate court can freely make. See Miss Universe, Inc. v. Patricelli, 408 F.2d 506 (2d Cir. 1969).

As the quotation above indicates, the factors suggested therein are to be joined to form an overall evaluation. Cf. King Research, supra; Chandon Champagne Corp. v. San Marino Wine Corp., 335 F.2d 531, 536 (2d Cir. 1964), and 2 McCARTHY § 24:6, at 134. If this Court is to uphold Judge Brieant's judgment to any extent, it must first weigh the facts against these factors and conclude that there has been a clear showing that the public will in all probability be confused if defendants use the word "lampoon" alone or with a qualifying word as a title, or in or as a set on its program. It is not sufficient that the possibility of confusion be present. Carter-Wallace, Inc. v. The Proctor & Gamble Co., 434 F.2d 794, 804 (9th Cir. 1970). "Likelihood of confusion" in this context means the probability of confusion. 3 CALLMAN, THE LAW OF UNFAIR COMPETITION, TRADE-MARKS AND MONOPOLIES, § 80, at 540 (hereinafter "CALLMAN"); 2 McCARTHY, § 23:1, at 36.

Judge Brieant's opinion in this case is much like that discussed in Miss Universe, Inc. v. Patricelli, supra, at 510, in that it places a great deal of emphasis on the parties' acts and intent, and with regard to many of the other factors, it speaks in terms of broad generalities and conclusions, unsupported by subordinate facts.

Defendants contend that the record provides no support for Judge Brieant's finding of bad faith (Op.-27). This finding is apparently based upon Judge Brieant's belief that Pudney directed that a presentation be prepared, employing the title "Lampoon" (cf. Op.-27, 26, 25, 23). However, the transcript page relies on (at Op.-23) by Judge Brieant as stating that Pudney testified that the title "Lampoon" was acquired in late October or early November contains no such testimony. Rather, Pudney quite clearly testified on that page that the first of two presentations, given to him in late October or early November, already bore the title "Lampoon". This is consistent with Schlatter's testimony (Tr-230-231). Judge Brieant is correct in finding that Pudney asked that a presentation be prepared. However, this was the second, revised presentation (Def. Ex. 17, marked "Second Draft").

Thus, it was Schlatter who approached ABC with the title "Lampoon", and as Judge Brieant states (at Op.-27), there is nothing to indicate that he ever knew of ABC's negotiations with plaintiff. By the time a second presentation was given to ABC, Schlatter had received the results of a legal title search which had informed him that he could use the title (cf. Op.-24). He and ABC proceeded from that point on under that belief.

But irrespective of the above, it must be realized that intent, or bad faith, cannot by itself lead to a determination of confusion. Miss Universe, Inc., 408 F.2d at 510. It

is this which Judge Brieant lost sight of.

"Lampoon", as discussed thoroughly above, is an ordinary dictionary word naming plaintiff's products. Thus, even if it were able to serve as a trademark, it would be considered a very "weak" mark. Cf. Sunbeam Lighting Co. v. Sunbeam Corp., 183 F.2d 969 (9th Cir. 1950). This means that minimal protection would be afforded the mark, and even in the area in which the mark functions, only an exact or near duplicate of the mark will be precluded. See, e.g., Miss Universe, Inc. v. Patricelli, supra ("Miss World-U.S.A." allowed as against "Miss U.S.A."); Sunbeam Lighting Co. v. Sunbeam Corp., supra (manufacturer of "Sunbeam" electrical appliances not allowed to restrain use of identical mark with regard to fluorescent lights); American Radiator & Standard Sanitary Corp. v. Sunbeam Corp., 125 F.Supp. 839 (S.D.N.Y. 1954) ("Sunbeam" on air conditioning units allowed).

In the instant case, defendants do operate in a different medium from plaintiff's existing products. Defendants' proposed mark, "Lampoon", as it would appear and be used in title and sets of defendants' show is obviously distinct in script and in distinctive element from plaintiff's mark NATIONAL LAMPOON. Some cases, in comparing such marks, have noted that even "a small difference in spelling or appearance may be sufficient to distinguish [the marks] and to avoid

a finding of confusing similarity." The Seven-Up Company v. Tropicana Products, Inc., 148 U.S.P.Q. 604 (CCPA 1966). See also: Juvenile Shoe Corp. of America v. Camp & McInnes, Inc., 160 U.S.P.Q. 505 (TMT App. Bd. 1968); and Eastern Wine Corp. v. Winston-Warren Ltd., 137 F.2d 955 (2d Cir. 1943), cert. den., 320 U.S. 758 (1944). This is particularly true where a plaintiff's mark consists of a qualifying, distinctive element, added to an otherwise generic term. See, e.g., Coca Cola Co. v. Snow Crest Beverages, 162 F.2d 280 (1st Cir. 1947). ("POLAR COLA" allowed with reference to COCA-COLA).

In the instant case, plaintiff uses the distinctive word NATIONAL with "Lampoon," just as Harvard Lampoon, Inc. uses the distinctive word HARVARD with the word. Plaintiff's chief executive felt that there was no confusion between these two products. By the same token, the use of the word "Lampoon" alone, in an entirely different medium, would not tend to confuse the public. It must be kept in mind in this context that

"... mere similarity, absent a resemblance between their products, does not constitute infringement or unfair competition. American Steel Foundries v. Robertson, 269 U.S. 372, 46 S.Ct. 160, 70 L.Ed. 317. There must be more than that. There must be proof that such similarity has resulted or may result in confusion in the minds of consumers as to the source or origin of the products involved, confusion which has led or might lead a purchaser of defendant's goods to believe he was purchasing those of the plaintiff." Polaroid Corp. v. Polarad Electronics Corp., 182 F.Supp. 350, 352-353 (E.D.N.Y. 1960), aff'd, 287 F.2d 492 (2d Cir. 1961).

In this sense, it is essential that one keep in mind that "likelihood of confusion", as dealt with here, means that the consumer, in seeking a particular product, is likely to be confused into believing that the defendants' product emanates from a single source, plaintiff. This consumer must be deemed to be the purchaser exercising due care in the marketplace. Cf. Vitarroz Corp. v. River Brand Rice Mills, Inc. 266 F. Supp. 981 (S.D.N.Y. 1967), at 986. Such a consumer could not be confused in this instance.

The lack of any indication of likelihood of confusion holds true not only with regard to the titles involved alone, but also with regard to the entirety of the products bearing the titles. The very nature of the contents of plaintiff's products is more than sufficient to distinguish these products from defendants' proposed show in the mind of any reasonable viewer. All the products are very caustic, and employ macabre "sick" humor, and they all frequently use blue material. This is seconded by Pudney (Tr-480), by plaintiff's own

Exhibit 10, a review of one of its books (referring to it as "gross, tasteless, sophomoric, semi-pornographic and downright subversive") and by Simmons himself (Tr-189-190 - conceding that the magazine could well offend a substantial number of people).

Judge Brieant passed completely over the caustic and macabre elements of plaintiff's products, concentrating instead only on the "blue" element. With regard to this element he apparently felt that defendants' show too contained some blue material, but that both would be "cleaned up" for TV. This misses the point, however. Plaintiff's products may be cleaned up for TV, but they are presently known to the public as they now exist. When defendants' show is "cleaned up" by censors, it will not contain the same type of materials by which plaintiff's products would be known to its buying public, and thus, there would not be a likelihood of confusion.

In keeping with the characteristics of Plaintiff's products, the evidence demonstrates that these products appeal to a specialized and limited audience. Articles submitted by Plaintiff itself confirm this. (See Pl. Ex. 9, articles by Hal Prouvner, Frank Bierman, Dave McQuay.) Indeed, Plaintiff's own survey (Ex. 22) confirms that its products generally appeal to a young audience and are primarily male-oriented. Plaintiff's own exhibit (#26), a piece of promotional material for the NATIONAL LAMPOON RADIO HOUR, points out that both the NATIONAL LAMPOON and the NATIONAL LAMPOON RADIO HOUR are aimed at a college-age audience. And a quotation from the BALTIMORE SUN set forth in that promotional material states: "Natlamp, as the book bills itself, is decidedly, hopelessly psychopathic. It displays the classic symptoms of the disorder: charm, shrewdness, willfulness, paranoia... Most importantly, it is utterly ruthless. It is the ruthlessness, I think, that gives the magazine its cruel bite and, paradoxically, makes it so funny."

Even in physical characteristics, Plaintiff's products are readily discernible from the proposed show. Plaintiff's magazine, apart from the nature of its content, is really little different from any other magazine, containing articles, an editorial page, letters to the editor, and so forth. Its theater production Lemmings (upon which its first proposed TV show would be based, and which is similar to its proposed closed-circuit TV production) is described by Simmons at Tr.91-92, and is nothing like Defendants' show. And Plaintiff's radio show includes such things as long (e.g., 23 minutes) discussions on humor, an idea totally foreign to Defendants' proposed show.

Another point must be made with reference to the plaintiff's radio show. Plaintiff could never satisfy its burden relative to "likelihood of confusion" if such likelihood is judged on the basis of the radio show. That show has been on the air but a few short months. Indeed a great deal of the stations which now carry it haven't even carried it for that long a period of time. Plaintiff introduced nothing which would tend to show any substantially widespread public familiarity with this show.

A final point in this connection is that the body of defendants' show, as now filmed, contains a specific disclaimer of any connection with the plaintiff (Tr. 284-285; Def. Ex. E).

The nature of the content of plaintiff's products would lead the ordinary consumer to believe that plaintiff could not enter television. As the discussion at pp. 13-15 , supra, indicates, this is factually true as well.

The totality of the above makes it clear that there can be no likelihood of confusion in this case. Indeed, even Simmons, when asked if people would tune into defendants' show assuming that they would see a transposition his product, could only say that it was very possible (Tr. -186). Even he cannot believe that there will be a likelihood, i.e., probability, of confusion.

Since both the claims of trademark infringement and unfair competition hinge on this question of likelihood of confusion [See Avon Shoe Co. v. David Crystal, Inc., 297 F.2d 607 (2d Cir.), cert. den., 364 U.S. 909 (1960)] the judgment below must be overturned in all respects.

THE OVER-BREADTH OF THE JUDGMENT BELOW

Even if none of those things discussed above were so, the judgment below would have to be drastically altered because of its drastic over-breadth. In this sense, the judgment is very similar to that in Miss Universe, Inc. v. Patricelli, 408 F.2d 506 (2d Cir. 1969), where, in dealing with a judgment much like the one at hand, this Court aptly stated:

"Instead of imposing sanctions to remedy the wrongs it decided were being inflicted upon the appellee, the trial court, at the urging of the appellee, has created a kind of cordon sanitaire around the appellee's registered service marks. . . ." [at 510-511]

This Court then went on to note:

"... The right to which appellee is entitled is that of being protected against encroachments on its registered marks, not of having the aid of a decree to create or support an enlarged monopoly" [id.]

The judgment in the present case would not allow even for a title: "Schlatter's Lampoon Which Isn't Connected With NATIONAL LAMPOON". And even given such a title, it wouldn't allow the use of a set consisting of the word "Lampoon". And it could not be satisfied by the most drastic of disclaimers, one of which defendants' show presently contains (cf. Tr. 284-285). Analogous to the Miss Universe trial court judgment, it tends to grant a virtual monopoly in the word "lampoon", and must be drastically altered.

CONCLUSION

For all the foregoing reasons, we respectfully submit that the judgment below should be reversed and that the complaint should be dismissed. In the alternative, we submit that the judgment should be amended so as to call for the use of "Lampoon" together with some other qualifying word in the title, and the free use of the sets consisting of or using the word "Lampoon".

Respectfully submitted,

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